

REMARKS

As a preliminary matter, applicant notes that the Office Action indicates that 69 claims (claims 1-69) are pending. However, applicant counts 65 claims as filed, and respectfully requests clarification of this apparent discrepancy. Applicant further notes that page 3 of the office action rejects claims 1-69 as being anticipated under 35 USC 102(e), and as such applicant has treated this as a rejection of claims 1-65.

Claims 1-65 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter of the invention. Applicant respectfully traverses the rejection.

The Examiner notes that the claims are broad, since they set forth physical characteristics rather than specific compositions. However, applicant notes that the claims, in one aspect, are directed to absorbent articles having components comprising a top sheet, a back sheet and an absorbent core having improved leakage protection.

Applicant has discovered that improved leakage protection is achievable in articles having certain defined relationships of physical parameters as set forth in the claims. While the language may be broad, it is applicant's position that the breadth of the claim is not a proper basis for a rejection under 35 U.S.C. § 112. Moreover, the definiteness of the particular language employed in the claims must be analyzed in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art, and not in a vacuum. *In re Angstadt*, 190 U.S.P.Q. 214, 217 9C.C.P.A. 1976).

"An applicant is entitled to claims as broad as the prior art and the application disclosure will allow." *In re Ramussen*, 211 U.S.P.Q. 323, 326 (C.C.P.A. 1981). The breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 169 U.S.P.Q. 597, 600 (C.C.P.A. 1971). If the scope of the subject matter embraced by the claim is clear on its face, the claim complies with Section 112, second paragraph.

It is well established that if the claims, when read in light of the specification, reasonably apprise those skilled in the art of the scope of the invention, § 112 demands no more. Applicant respectfully submits that the scope of the present claims will be

apparent to those skilled in the art, based on the present specification. Further, applicant has fully disclosed a test methodology and measurement parameters that provide for designing absorbent articles with improved performance, which is indeed an aspect of the present invention. Accordingly, applicant is entitled to claim these inventive aspects.

Claims 1-65 also stand rejected under 35 U.S.C. § 102(e)/103(a) as being anticipated by, or obvious in view of, Alemany et al. (U.S. Patent No. 4,834,735). This ground of rejection is respectfully traversed.

The Examiner states that the Alemany et al. reference discloses materials similar to those disclosed by applicant, and that since such materials are similar, they would be expected to have the same performance characteristics. The Examiner concludes that this is sufficient to establish inherency regarding the performance characteristics claimed by applicant. Applicant respectfully disagrees.

It is applicant's position that a general discussion of similar materials is not sufficient to establish that articles disclosed by Alemany necessarily possess the characteristics that satisfy the claimed performance parameters, and the Examiner's position is at best mere conjecture. Alemany et al. is completely silent regarding performance parameters recited in the present claims, or the use of these parameters to select specific materials and components that meet the performance requirements as claimed. See, for instance, the present specification at paragraphs 0064, 0081, 00121, 00123 and 00125, which illustrate the development and use of the claimed performance parameters to identify and select specific materials to satisfy specific performance parameters. i.e. improved leakage protection.

Further, there is no evidence in Alemany et al., or any reasoning provided by the Examiner, that the product of Alemany et al. necessarily exhibits the performance parameters as claimed. Accordingly, applicant respectfully submits that the Examiner has not presented evidence or reasoning tending to show inherency.

"To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not

sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)

As to the argument that it would have been obvious for one of ordinary skill to find an optimum value of AUL (absorbency under load) by routine experimentation, applicant submits that, first of all, this has not been established by concrete evidence, and further, this would not remedy the deficiencies of the reference as discussed above. Moreover, applicant also maintains that routine experimentation does not supply the missing descriptive matter in the reference as also noted above.

In view of the foregoing facts and reasons, the present application to be in proper condition for allowance. Accordingly, favorable consideration prompt allowance of the application are respectfully requested. The Examiner is requested to contact Applicants' undersigned representative at the telephone number below to discuss any matters pertaining to this application.

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